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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,263	12/18/2000	Keith Barraclough	8X8S.223PA	5757

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EXAMINER

MANNING, JOHN

ART UNIT PAPER NUMBER

2623

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/740,263

Applicant(s)

BARRACLOUGH ET AL.

Examiner

John Manning

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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ADVISORY ACTION

Response to Arguments

Applicant's arguments filed 9/11/2006 have been fully considered but they are not persuasive.

Applicant states:

The Final Office Action alleges an antecedent basis issue, suggesting that "the plurality of appliances" has insufficient antecedent basis in referring to a "plurality of telephony-based appliances." Applicant respectfully traverses any such objection because antecedent basis in the context of Section 112 or otherwise does not require word-for-word correspondence; rather, where the scope of a claim would be reasonably ascertainable by those skilled in the art, the claim is not indefinite. In this instance, the language in claim 3 referring to appliances as referred to in an earlier claim also referencing the appliances would be ascertainable by those skilled in the art. In this regard, Applicant submits that any objection to claim 3 would be improper.

The examiner disagrees. The objection of claim 3 is maintained.

Applicant states:

Regarding the rejection of the independent claims, the cited combination of references fails to teach or suggest limitations directed to a data memory circuit that stores packet-based data (or external-services data).

The examiner disagrees. The previous Office Action explicitly addresses the aforementioned limitation. Specifically, Hamlin teaches system database storage 48 within the system controller that holds information on the status of the distribution system 10. The database 48 stores information that is useful in configuring and controlling the system [col. 4, lines 16-27]. Furthermore, the Ellis reference teaches a server 80, as the primary device in the home [Fig. 5 and paragraph 0074]. The server, as taught with reference to a separate embodiment, handles data distribution tasks and

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stores local information. The server may be used to implement a client-server based interactive television program guide system. Also, the server 42 may be capable of handling text, graphics, and video [paragraph 0062].

Applicant states:

Applicant further traverses each of the Section 103(a) rejections because the Final Office Action fails to present any evidence of motivation for making the asserted modifications. Obviousness cannot be established by combining teachings of the prior art to produce a claimed invention absent some teaching, suggestion, or incentive supporting the combination.

The examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant states:

The following discussion addresses the Response to Arguments in the Final Office Action in an effort to clarify any misunderstanding as to the teachings of the Hamlin reference, the proposed modification of these teachings, and Applicant's prior remarks concerning the same. Specifically, page 2 of the Final Office Action cites Applicant's arguments concerning the prior Office Action's suggestion that a skilled artisan would provide **caller ID** information to television receiving units 46 of the Hamlin reference. The Response indicates that the Examiner disagrees with the Applicant, but the rationale provided in alleged support of this disagreement does not pertain to the issue at hand, namely, to providing **caller ID** information to television receiving units. Instead, the Examiner describes an interpretation that telephony is "the science of transmitting voice, data, video or image signals" and cites several paragraphs from the Hamlin reference that discuss the multitude of available

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communications mediums and their home use, and an approach to providing such communications over a common signal distribution system 10. In his discussion, however, *there is no citation to any teaching, suggestion or motivation for displaying a caller ID on a television.*

The examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., caller ID information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant states:

In addition to the above, Applicant further submits that the Final Office Action fails to address and answer Applicant's traversals in a manner consistent with M.P.E.P. § 707.07(f), and that rejections in the Final Office Action are therefore improper. Specifically, the Applicant traversed all of the rejections in the Office Action Response filed on March 15, 2006. However, the Final Office Action appears to address only one traversed issue regarding an improper suggestion that one of skill in the art would modify Hamlin to include providing caller ID information to a television. The Final Office Action does not address other traversals relating to, for example, the failure of the cited references to teach or suggest various claim limitations, and the lack of evidence of motivation for modifying the Hamlin reference. In this regard, the Final Office Action fails to address Applicant's traversals as required. Should any claim rejections be maintained, Applicant requests that the finality of the Office Action mailed on July 11, 2006 be withdrawn, and that the Examiner address Applicant's traversals in the Office Action Response mailed on March 15, 2006.

The examiner disagrees. The arguments presented in the previous response and in the current response were/are unpersuasive. Consequently, the finality of the previous Office Action is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM
October 6, 2006

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